



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,014	06/15/2001	Michael Smith	1826 (42059-01360)	9634

20350 7590 10/08/2003

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
----------	--------------

2171

DATE MAILED: 10/08/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/883,014

Applicant(s)

SMITH, MICHAEL

Examiner

Etienne P LeRoux

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3, 4, 12, 13, 14 and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following claims contain the following trademark/trade names:

Claim 3: Domino Server and Lotus Notes

Claim 4: \$PeoplesGroupFlat

Claim 12: Lotus Notes

Claim 13: Domino Server

Claim 14: \$PeoplesGroupFlat

Claim 17: Domino Server and Lotus Notes

Claim 19: \$PeoplesGroupsFlat

Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the

Art Unit: 2171

trademark/trade name is used to identify/describe a software application which allows parties to manage and access information across a number of different computing platforms and, accordingly, the identification/description is indefinite.

Claim 18 is rejected on the basis of being dependent from a rejected claim.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 5,517,014 issued to Iijima (hereafter Iijima '014).

**Claim 1:**

Iijima '014 discloses a method of configuring a shared directory hosted environment comprising the steps of:

- providing access over at least one data network to a shared a directory, wherein the directory is configured to include at least one entry for each entity authorized to employ information stored in the directory; including in the at least one entry an editable form which when filled with identification information for the entity creates a wild card entry which is accessible when the directory is searched;
- restricting access to a first view directory when entities access the directory to access the at least one entry; and

Art Unit: 2171

- creating a second view of the directory, wherein the second view is configured with selection criteria matching that provide for locating and retrieving on the at least one entry in the directory with matching identification information as that of the at least one entity [claim 1]

Claim 2:

Iijima '014 discloses wherein the entities comprise at least one of at least one person and at least one group [col 1, lines 30-35].

Claim 5:

Iijima '014 discloses wherein the hierarchal information relates to at least one of: an organization and a location [col 1, lines 55-65].

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iijima '014 in view of Pub No US 2002/0174194 issued to Mooney et al (hereafter Mooney '194).

Claim 3:

Iijima '014 discloses the elements of claim 1 as noted above.

Iijima '014 fails to disclose wherein directory is hosted on a Domino server employing Lotus Notes messaging.

Art Unit: 2171

Mooney '194 discloses wherein directory is hosted on a Domino server employing Lotus Notes messaging [paragraph 12]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Iijima '014 to include wherein directory is hosted on a Domino server employing Lotus Notes messaging as taught by Mooney '194.

The ordinarily skilled artisan would have been motivated to modify Iijima '014 as per the above for the purpose of setting up an e-mail account on a group-wise basis [paragraph 12].

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iijima '014 in view of Pub No US 2003/0101493 issued to Mercuriali et al (hereafter Mercuriali '493).

Claim 6:

Iijima '014 discloses the elements of claim 1 as noted above.

Iijima '014 fails to disclose wherein the directory is employable for providing emessaging services.

Mercuriali '493 discloses wherein the directory is employable for providing emessaging services [paragraph 27].

It would have been obvious to one of ordinary skill in the art at the time the invention as made to modify Iijima 014 to include wherein the directory is employable for providing emessaging services as taught by Mercuriali '493.

The ordinarily skilled artisan would have been motivated to modify Iijima '014 per the above for the purpose of providing access control by means of an access control module [paragraph 27]

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iijima '014 in view of Pub No US 2002/0131573 issued to Berkley et al (hereafter Berkley '573).

Claim 7:

Iijima '014 discloses the elements of claim 1 as noted above.

Iijima '014 fails to disclose wherein identification information is configured in hierarchal form and includes at least one of company name and company location.

Berkley '573 discloses wherein identification information is configured in hierarchal form and includes at least one of company name and company location [paragraph 45].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Iijima '014 to include wherein identification information is configured in hierarchal form and includes at least one of company name and company location as taught by Berkley '573.

The ordinarily skilled artisan would have been motivated to modify Iijima '014 as per the above for the purpose of identifying the user [paragraph 45]

9. Claims 8 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iijima '014 in view of Pub No US 2002/0184191 issued to Marpe et al (hereafter Marpe '191).

Art Unit: 2171

Claims 8 and 15:

Iijima '014 discloses a method for presenting address information to accessing parties in a shared directory environment comprising the steps of: detecting query from at least one entity over a data network seeking a first view of at least one entry in a shared directory; searching the shared directory and locating and retrieving identification information for the at least one entity; denying access to the first view, and based on the hierarchal information identifying all of the at least one entries in the directory which include the hierarchal information; and presenting all the of the identified at least one entries in a second view.

Iijima '014 discloses the above noted elements of claim 8.

Iijima '014 fails to disclose wherein the identification information for each of the at least one entries in the shared directory include an additional field which provides for input of hierarchal information which creates a wild card entry for the hierarchal information portion of the at least one entry.

Marpe '191 discloses wherein the identification information for each of the at least one entries in the shared directory include an additional field which provides for input of hierarchal information which creates a wild card entry for the hierarchal information portion of the at least one entry [paragraph 495].

It would have been obvious to one of ordinary skill in the art at the time the invention was madder to modify Iijima '014 to include wherein the identification information for each



Art Unit: 2171

of the at least one entries in the shared directory include an additional field which provides for input of hierarchal information which creates a wild card entry for the hierarchal information portion of the at least one entry as taught by Marpe '191.

The ordinarily skilled artisan would have been motivated to modify Iijima 014 as per the above for the purpose of performing searching of all contacts [paragraph 494].

Claim 16:

The combination of Iijima '014 and Marpe '191 discloses the elements of claim 15 as noted above.

The combination of Iijima '014 and Marpe '191 discloses wherein the date network is the internet and the interface is configured to communicate with web browsers [Marpe '191 paragraph 2].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include wherein the date network is the internet and the interface is configured to communicate with web browsers as taught by Marpe '191.

The ordinarily skilled artisan would have been motivated to include wherein the date network is the internet and the interface is configured to communicate with web browsers. for the purpose of incorporating data which is distributed across a network [paragraph 2]

Art Unit: 2171

10. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Iijima '014 and Marpe '191 and further in view of Mercuriali '493.

Claim 9:

The combination of Iijima '014 and Marpe '191 discloses the elements of claim 8 as noted above.

The combination of Iijima '014 and Marpe '191 fails to disclose wherein the shared directory is configurable for supporting emessaging.

Mercuriali '493 discloses wherein the directory is employable for providing emessaging services [paragraph 27].

It would have been obvious to one of ordinary skill in the art at the time the invention as made to modify the combination of Iijima '014 and Marpe '141 to include wherein the directory is employable for providing emessaging services as taught by Mercuriali '493.

The ordinarily skilled artisan would have been motivated to modify the combination of Iijima '014 and Marpe '191 per the above for the purpose of providing access control by means of an access control module [paragraph 27]

Claim 10:

Iijima '014 discloses wherein the entities comprise at least one of at least one person and at least one group [col 1, lines 30-35].

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Iijima '014 and Marpe '191 and further in view of Berkley '573.

Art Unit: 2171

Claim 11:

The combination of Iijima '014 and Marpe '191 discloses the elements of claim 8 as noted above.

The combination of Iijima '014 and Marpe '191 fails to disclose wherein identification information is configured in hierarchal form and includes at least one of company name and company location.

Berkley '573 discloses wherein identification information is configured in hierarchal form and includes at least one of company name and company location [paragraph 45].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Iijima '014 and Marpe '191 to include wherein identification information is configured in hierarchal form and includes at least one of company name and company location as taught by Berkley '573.

The ordinarily skilled artisan would have been motivated to modify the combination of Iijima '014 and Marpe '191 as per the above for the purpose of identifying the user [paragraph 45]

12. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Iijima '014 and Marpe '191 and further in view of Mooney '194.

Claim 12:

The combination of Iijima '014 and Marpe '191 discloses the elements of claim 8 as noted above.

The combination of Iijima '014 and Marpe '191 fails to disclose wherein the directory is configured on a domino server as part of a Lotus Notes application.

Mooney '194 discloses wherein the directory is configured on a domino server as part of a Lotus Notes application [paragraph 12]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Iijima '014 and Marpe '191 to include wherein the directory is configured on a domino server as part of a Lotus Notes application as taught by Mooney '194.

The ordinarily skilled artisan would have been motivated to modify the combination of Iijima '014 and Marpe '191 per the above for the purpose of setting up an e-mail account on a group-wise basis [paragraph 12].

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Iijima '014 and Marpe '191 and Mooney '194 and further in view of Pub No US 2002/0029250 issued to Reiner (hereafter Reiner '250).

Claim 13:

The combination of Iijima '014 and Marpe '191 and Mooney '194 discloses the elements of claims 8 and 12 as noted above.

The combination of Iijima '014 and Marpe '191 and Mooney '194 fails to disclose wherein the domino server provides hosted messaging services for a plurality of third parties.

Reiner '250 discloses wherein the domino server provides hosted messaging services for a plurality of third parties [paragraph 11]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Iijima '014 and Marpe '191 and Mooney '194 to include wherein the domino server provides hosted emessaging services for a plurality of third parties as taught by Reiner '250.

The ordinarily skilled artisan would have been motivated to modify the combination of Iijima '014 and Marpe '191 and Mooney '194 for the purpose of using a proven product from a company.

14. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Iijima '014 and Marpe '191 in view of Mooney '194.

Claim 17:

The combination of Iijima '014 and Marpe '191 discloses the elements of claim 15 as noted above.

The combination of Iijima '014 and Marpe '191 fails to disclose wherein the network interface and the directory are configured on Domino server employing Lotus Notes application.

Mooney '194 discloses wherein the network interface and the directory are configured on Domino server employing Lotus Notes application [paragraph 12]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Iijima '014 and Marpe '191 to include wherein the network interface and the directory are configured on Domino server employing Lotus Notes application as taught by Mooney '194.

The ordinarily skilled artisan would have been motivated to modify the combination of Iijima '014 and Marpe '191 per the above for the purpose of setting up an e-mail account on a group-wise basis [paragraph 12].

Claim 18:

The combination of Iijima '014, Marpe '191 and Mooney '194 discloses the elements of claims 15 and 17 as noted above.

The combination of Iijima '014, Marpe '191 and Mooney '194 discloses wherein the interface and directory are configured to provide hosted emessaging services for a plurality of third parties [Marpe '191 abstract].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include wherein the interface and directory are configured to provide hosted emessaging services for a plurality of third parties as taught by Marpe '191.

The ordinarily skilled artisan would have been motivated to modify the combination of Iijima '014, Marpe '191 and Mooney '194 to include wherein the interface and directory are configured to provide hosted emessaging services for a plurality of third parties for the purpose of setting up an e-mail account on a group-wise basis.

15. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Iijima '014 and Marpe '191 and further in view of Pub No US 2002/0076015 issued to Norwitz et al (hereafter Norwitz '015).

Claim 20:

The combination of Iijima '014 and Marpe '191 discloses the elements of claim 15 as noted above.

The combination of Iijima '014 and Marpe '191 fails to disclose wherein the fields are provided for at least one of: people entries and group entries in the directory.

Norwitz '015 discloses

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Iijima '014 and Marpe '191 to include as taught by Norwitz '015.

The ordinarily skilled artisan would have been motivated to modify the combination of Iijima '014 and Marpe '191 per the above for the purpose of permitting users in a subscribing organization to communicate with others [abstract].

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Art Unit: 2171

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Etienne LeRoux

September 26, 2003

*ELR*

*S. Metjahic*

SAFET METJAHIC  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100